

2. Image Media engages in the business of advertising by way of outdoor displays, such as billboards, and has been in business since 1989.

3. Image Media has operated under the name "Image Media" since its inception.

4. Image Media has also used the following logo, referred to herein as the "Image Media Logo," with its operations since 1989.



5. Image Media is the owner of U.S. Trademark Registration 5548925 for the Image Media Logo. Ex. 1.

6. The predominant portion of the Image Media Logo is the words "Image Media."

7. Image Media has also used the following logo, referred to herein as the Image Media Skyline Logo," with its operations since 2011.



8. Image Media is the owner of U.S. Trademark Registration 5559326 for the Image Media Skyline Logo. Ex. 2.

9. A predominant textual portion of the Image Media Skyline Logo consists of the words "Image Media" placed over a Chicago skyline silhouette.

10. Image Media also has common law trademark rights in the word mark IMAGE MEDIA through its decades of use of that mark with its goods and services, and which is referred to herein as the “Image Media Word Mark.”

11. Image Media has protectable trademark rights over each of the Image Media Logo, the Image Media Skyline Logo, and the Image Media Word Mark, which are collectively referred to herein as the “Image Media Trademarks.”

12. Defendant, Image Media One, LLC (“Image Media One”), is a limited liability company organized under the laws of the State of New York, and has a place of business at 1501 Broadway, Suite 12084, New York, NY 10036.

13. Image Media One engages in the business of marketing and advertising by way of outdoor displays, such as billboards, and has been in business since 2010.

14. Image Media and Image Media One each offer substantially similar or highly related services.

15. Image Media and Image Media One each advertise, promote, and market their respective services through similar channels.

16. Image Media One had conducted, and continues to conduct business in several locations, including in Chicago, Illinois.

RELEVANT FACTS

17. Image Media One advertised or advertises its services under the name “Image Media One”.

18. Image Media One owns the domain name “www.imagemediaone.com.”

19. Image Media One used the domain name “www.imagemediaone.com” in commerce to market and advertise its services.

20. Image Media One operated other websites with domain names that included the terms "image" and "media."

21. Image Media One has, without authorization from Image Media, advertised, marketed, and promoted its services within this district under the brand "Image Media One".

22. Image Media One, without authorization from Image Media, incorporated the entirety of Image Media's trademark in the domain name "www.imagemediaone.com".

23. On information and belief, Image Media One was aware of Image Media and its business prior to adoption of the brand "Image Media One" or the domain name "www.imagemediaone.com".

24. On information and belief, Miller was aware of Image Media and its business prior to adoption of the name "Image Media One" and domain www.imagemediaone.com.

25. On information and belief, Image Media One and Miller intended to trade off of the goodwill of Image Media through their adoption of the name "Image Media One" and the domain www.imagemediaone.com.

26. Image Media One was sent a letter dated October 23, 2017 notifying Image Media One of Image Media's belief that Image Media One's actions were likely to cause consumer confusion by way of a letter addressed to its President, Michael Miller. Ex. 3.

27. Since at least shortly after October 23, 2017, Image Media One had actual notice of one or more of the Image Media Trademarks, and Image Media's claims of infringement.

28. Image Media One and Miller declined to respond to the October 23, 2017 letter.

29. Image Media One was again notified on or about July 20, 2018 of Image Media's belief that Image Media One's actions were likely to cause consumer confusion by way of a letter addressed to Michael Miller. Ex. 4.

30. Image Media One and Miller declined to respond to the July 20, 2018 letter.

31. On information and belief, Michael Miller is an individual residing in New York, who founded, is president, and is the managing agent of Image Media One.

32. Image Media One and Mr. Miller ignored and failed to respond to each of the October 23rd and July 20th letters, and continued to use the name “Image Media One” in commerce and to use the domain name www.imagemediaone.com for commercial purposes.

33. Image Media One’s use of the name “Image Media One” and the domain name www.imagemediaone.com has caused actual consumer confusion in the marketplace, and has harmed Image Media’s business.

34. Image Media One’s use of the name “Image Media One” and the domain name www.imagemediaone.com was likely to cause consumer confusion regarding the source, affiliation, connection or association of its services and Image Media.

35. After several failed attempts to engage with Image Media One regarding Image Media's infringement concerns, Image Media filed a complaint for, *inter alia*, trademark infringement in the United States District Court for the Northern District of Illinois in the case captioned *Image Media Advertising, Inc. v. Image Media One*, Case No. 2018 CV 00642.

36. After negotiations, Image Media and Image Media One entered into a Settlement Agreement. Ex. 5.

37. Pursuant to the Settlement Agreement, Case No. 2018 CV 00642 was dismissed without prejudice.

38. The Settlement Agreement specified that Image Media One would "cease and desist permanently all use of the phrase 'Image Media' as a trademark, and to not sell, market, advertise, promote, supply, distribute, or offer any goods or services under any name that

includes the words "image" and "media" in close proximity to each other, or use any other marks, designs, or designations that are identical to, substantially indistinguishable from, and/or confusing similar to Image Media's trademarks."

39. Despite the Settlement Agreement, Image Media One continues to market its services via the Internet, such as through LinkedIn. See Ex. 6.

40. Also contrary to the terms of the Settlement Agreement, on information and belief, Image Media One has adopted the name "Image One Media" and sold, marketed, advertised, promoted, supplied, distributed, and offered its services under that name.

41. The name "Image One Media" includes the words "image" and "media" in close proximity to each other.

42. The name "Image One Media" is confusingly similar to Image Media's trademarks.

43. Upon information and belief, Image Media One conducts business via email having the domain "imagemediaone.com".

44. Image Media has received inquiries based on Image Media One's activities. Ex. 7.

45. Consumers have been confused as to the source of Image Media One's services based on its use of the name "Image One Media."

JURISDICTION AND VENUE

46. This action is for (1) trademark infringement under the Federal Trademark Act, also known as the Lanham Act (15 U.S.C. §§ 1051-1127); (2) false designation of origin, or false or misleading description or representation of fact under § 43(a) of the Lanham Act (15 U.S.C. § 1125(a)); (3) unfair competition and deceptive trade practices under the Illinois Deceptive Trade

Practices Act (815 ILCS §§ 510/1-510/7), (4) trademark infringement and unfair competition under Illinois common law, and (5) breach of contract.

47. This Court has subject matter jurisdiction over this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338(a) and (b) and the pendent jurisdiction of this Court.

48. Defendant Image Media One is subject to personal jurisdiction in this judicial district because it regularly conducts business in this district and committed or is committing one or more of the acts complained of herein within this state and judicial district by advertising, promoting and marketing its services under the "Image Media One" and "Image One Media" names.

49. This Court has personal jurisdiction over Michael Miller as the managing agent of Image Media One and his control over its activities and his regular conduct of business in this district and his commission of one or more of the acts complained of herein within this state and judicial district by advertising, promoting and marketing the services if Image Media One under the "Image Media One" and "Image One Media" names. This Court further has personal jurisdiction over Defendants because they have had, and continue to have, continuous and systematic contacts with Illinois, including in this District.

50. Venue is proper in this juridical district pursuant to 28 U.S.C. § 1391(a)-(c) because a substantial part of the events complained of occurred in this district, defendants Image Media One and Michael Miller have knowingly committed tortious acts aimed at and causing harm in this state and this district, and Image Media One and Michael Miller are is subject to personal jurisdiction herein. Moreover, the damage to plaintiff Image Media and its registered and common law trademark described herein has occurred and continues to occur in this judicial district.

COUNT I (Federal Trademark Infringement)
15 U.S.C. Section 1114 – All Defendants

51. Plaintiff Image Media realleges and incorporates by reference paragraphs 1-50 of its Complaint as if fully set forth herein.

52. This Count is based on infringement of trademarks registered under the trademark laws of the United States and, more particularly, under 15 U.S.C. § 1051 et seq. Defendant Image Media One's unauthorized use of the confusingly similar names "Image Media One" and "Image One Media" and the domain name "www.imagemediaone.com" in association with its services was and is likely to cause confusion, mistake or deception as to the source, affiliation, connection or association of Image Media One with Image Media, or as to the sponsorship, approval or affiliation of Image Media One by or with Image Media, in violation of 15 U.S.C. §1114.

53. Image Media One had actual or constructive notice or knowledge (pursuant to 15 U.S.C. § 1072) of Image Media's Image Media Logo and its Image Media Skyline Logo and its exclusive rights therein.

54. Prior to the filing of the complaint in Case No. 2018 CV 00642, Image Media One refused to cease using the name "Image Media One" and the domain name www.imagemediaone.com despite Image Media's requests that it do so. Upon information and belief, Image Media One adopted the name "Image Media One" and registered the domain name www.imagemediaone.com with prior knowledge of Image Media's Image Media Logo and its Image Media Skyline Logo. Image Media One's use of "Image Media One" therefore constituted willful infringement of Image Media's registered marks, and make this an exceptional case under 15 U.S.C. § 1117(a).

55. Subsequent to the Settlement Agreement, Image Media One began using the name "Image One Media", which constitutes willful infringement of Image Media's registered marks, and makes this an exceptional case under 15 U.S.C. § 1117(a).

56. Since the execution of the Settlement Agreement, Image Media One continued to use the name "Image Media One" on the internet for marketing and advertising of its services.

57. Since the execution of the Settlement Agreement, Image Media One continued to advertise the domain name www.imagemediaone.com on the internet along with the marketing and advertising of its services.

58. As a result of Image Media One's willful infringement, Image Media has been, is now, and will continue to be damaged and irreparably harmed and thus, Image Media has no adequate remedy at law.

59. Image Media One will continue such infringement unless enjoined by this Court.

COUNT II (Federal Unfair Competition)
15 U.S.C. Section 1125(a) – All Defendants

60. Plaintiff Image Media re-alleges and incorporates by reference paragraphs 1-59 of its Complaint as if fully set forth herein.

61. This Count is based on false designation of origin and false description or representation in violation of 15 U.S.C. § 1125(a). Image Media has used and is currently using the name Image Media in commerce to identify its services and to distinguish them from the services of others.

62. Long after Image Media's first use of the name "Image Media," Image Media One began using its marks "Image Media One" and "Image One Media" to identify its services.

63. These act constitutes a false description and representation that Image Media One's services are authorized by, sponsored by or affiliated with Image Media, all in violation of 15 U.S.C. § 1125(a).

64. Image Media One's violation of 15 U.S.C. § 1125(a) is willful and deliberate.

65. As a result of Image Media One's willful and unlawful acts, Image Media has been, is now, and will continue to be damaged and irreparably harmed and thus, Image Media has no adequate remedy at law.

66. Image Media One will continue such infringement unless enjoined by this Court.

COUNT III
(Illinois Deceptive Trade Practices 815 ILCS § 501/1-501/7)
All Defendants

67. Plaintiff Image Media realleges and incorporates by reference paragraphs 1-66 of its Complaint as if fully set forth herein.

68. This Count is based on unfair competition and deceptive trade practices in violation of the Illinois Uniform Deceptive Trade Practices Act (815 ILCS § 501/1-501/7).

69. Image Media One, with full knowledge of Image Media's superior rights to the trademark "Image Media," willfully adopted and used the name Image Media One in connection with its services with the deliberate and express purpose of obtaining the benefit of Image Media's goodwill and reputation; and Image Media One's unfair or deceptive acts or practices likely caused, was intended to cause, and did actually cause confusion and deceived the public.

70. Image Media One, with full knowledge of Image Media's superior rights to the trademark "Image Media," willfully adopted and is using the name Image One Media in connection with its services with the deliberate and express purpose of obtaining the benefit of Image Media's goodwill and reputation; and Image Media One's unfair or deceptive acts or

practices are likely to cause, are intended to cause, and have actually caused confusion and deceived the public.

71. Image Media One's willful use of "Image Media One" "Image One Media" and www.imagemediaone.com is likely to cause confusion, mistake, or deception as to the source, sponsorship or approval of Image Media One's services and has created a likelihood of confusion or misunderstanding as to whether Image Media One is affiliated, connected to or associated with Image Media in violation of 815 ILCS § 501/1-501/7.

72. Unless enjoined by the Court, Image Media One will continue to do the acts complained of herein and to cause damage and injury to Image Media's business reputation and confusion as to the source of Image Media One's services, all to Image Media's and the public's irreparable harm, for which Image Media has no adequate remedy at law.

COUNT IV
(Common Law Trademark Infringement and Unfair Competition)
All Defendants

73. Plaintiff Image Media realleges and incorporates by reference paragraphs 1-72 of its Complaint as if fully set forth herein.

74. This Count is based on Illinois common law trademark infringement and unfair competition.

75. Image Media owns and has used its Image Media Logo, the Image Media Skyline Logo, and the name "Image Media" in connection with its services since at least as early as May 1989. Because of Image Media's longstanding and extensive use, they have become uniquely associated with Image Media and identifies Image Media's services. The Image Media Logo, Image Media Skyline Logo, and the name "Image Media" are valid trademarks under Illinois state common law.

76. Image Media One's acts constitute willful trademark infringement under the common law of Illinois, where Image Media One has used the name "Image Media One" and "Image One Media" which are confusingly similar to the Image Media Logo, Image Media Skyline Logo, and the name "Image Media".

77. Image Media One's unauthorized and infringing use in commerce of "Image Media One", "Image One Media" and www.imagemediaone.com constituted or constitutes willful unfair competition with Image Media under the common law, such that such use enabled or enables Image Media One to obtain the benefit of, and trade upon, the widespread recognition and goodwill of Image Media. Image Media has no control over Image Media One's business and services and its impact on Image Media's goodwill, so Image Media One's unlawful use of "Image Media One" "Image One Media" and www.imagemediaone.com is likely to cause confusion, mistake or deception, and result in Image Media One's unjust enrichment.

78. Unless enjoined by this Court, Image Media One will continue to cause irreparable harm to Image Media and the public, for which Image Media has no adequate remedy at law.

COUNT V
Breach of Contract
(Image Media One, LLC)

79. Plaintiff Image Media realleges and incorporates by reference paragraphs 1-78 of its Complaint as if fully set forth herein.

80. The Settlement Agreement is a valid and subsisting contract between Image Media and Image Media One.

81. Paragraph 2 of the Settlement Agreement provides that Image Media One would "cease and desist permanently all use of the phrase 'Image Media' as a trademark, and to not sell,

market, advertise, promote, supply, distribute, or offer any goods or services under any name that includes the words "image" and "media" in close proximity to each other, or use any other marks, designs, or designations that are identical to, substantially indistinguishable from, and/or confusing similar to Image Media's trademarks."

82. Image Media has fully performed its obligations under the Settlement Agreement.

83. Defendant Image Media One, by way of its use of the name "Image One Media" is in breach of the Settlement Agreement.

84. Defendant Image Media One, by way of its use of the name "Image Media One" is in breach of the Settlement Agreement.

85. Image Media One's breach is willful and in bad faith.

86. Plaintiff Image Media has sustained and is continuing to sustain damages by reason of that breach by Image Media One, in an amount yet to be determined.

RELIEF REQUESTED

WHEREFORE, Image Media respectfully requests that this Court enter judgment in its favor and against Defendants as follows:

- a. Find that each of the Defendants has violated §§ 32 and 43(a) of the Lanham Act (15 U.S.C. §§ 1114 and 1125(a)); and each of the Defendants has engaged in trademark infringement and unfair competition and deceptive trade practices under the common law and statutory law of the State of Illinois;
- b. Grant an injunction, pursuant to Rule 65 of the Federal Rules of Civil Procedure and 15 U.S.C. § 1116 permanently restraining and enjoining Defendants, its officers, agents, representatives, employees, successors, and assignees, and all those persons in active concert or participation with Defendants from:

- i. registering or using any designation that is owned by Image Media or that is identical or confusingly similar to any registered trademark owned by Image Media; advertising, marketing, promoting, supplying, distributing, selling, or offering for sale, any services relating thereto; and/or engaging in any other activity constituting an infringement of any of Image Media's rights in the Image Media mark;
 - ii. engaging in any other activity constituting unfair competition with Image Media, or acts and practices that deceive consumers, the public, and/or trade, including without limitation, the use of designations associated with Image Media;
 - iii. operating any website associated with, using, linking to, transferring, selling, exercising control over, or otherwise owning any domain name or trademark or service mark that incorporates, in whole or in part, any of the Image Media marks or any designation that is identical or confusingly similar thereto;
 - iv. Sign an order instructing the relevant host, registry, or registrar to disable domains registered to Defendant that incorporates the words "Image" and "Media" or that displays content implying a relationship with Image Media, or alternatively, to transfer any such domains to Plaintiff;
 - v. Require Defendants to file with this Court and serve on Image Media within thirty days after entry of the injunction a report in writing under oath setting forth in detail the manner and form in which Defendant has complied with the injunction;
- c. Such other relief as this Court may deem appropriate to prevent consumers, the public, and/or the trade from deriving any erroneous impression that any services at issue in this action have been advertised, marketed, promoted, supplied, distributed, offered for sale,

or sold by Defendant, has been authorized by Image Media, or is related in any way with Image Media and/or its services;

- d. Award Image Media actual, punitive damage, and/or statutory damages to which it is entitled under applicable federal and state laws;
- e. Recover from Defendants all damages that Image Media has sustained and will continue to sustain as a result of such infringing acts, and all ill-gotten gains, profits, and advantages obtained by Defendants, in an amount to be determined;
- f. Award Image Media its costs in this action, attorney's fees, investigatory fees, and expenses to the full extent provided by § 35 of the Lanham Act (15 U.S.C. § 1117) and 815 ILCS § 501/1-501/7;
- g. Award Image Media pre-judgment interest on the monetary award made part of the judgment against Defendants; and
- h. Award Image Media such additional and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Plaintiff hereby requests trial by jury for all issues for which a jury trial is appropriate.

Date: June 14, 2019

Respectfully submitted,

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